2685.2030 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Jennifer L. Schmitke, Donghao Chen, Richard P. Batycky, David A. Edwards and Jeffrey S. Hrkach

Application No: 09/888,126 Group No: 1616

Filed: June 22, 2001 Examiner: Mina Haghighatian

Confirmation No.: 9053

Title: PARTICLES FOR INHALATION HAVING RAPID RELEASE PROPERTIES

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REPLY BRIEF

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Sir:

This Reply Brief is being filed pursuant to Rule 41.41 in response to the Examiner's Answer mailed September 20, 2005. The Brief filed on June 28, 2005 is incorporated herein by reference.

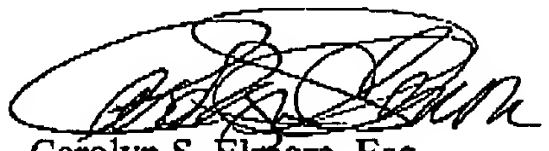
The Examiner concludes that the Appellants agree that the Examiner has established a *prima facie* case of obviousness. While it is true that the Appellants have chosen not to argue, in this appeal, whether or not the Examiner has established a prima facie case of obviousness (or whether or not Patton and/or Edwards taken in any combination or with any other references make out such a prima facie case), relying instead on evidence that rebuts any such *prima facie* case, Appellants would like to make clear that they have not made such an admission explicitly or inferentially.

The Examiner has acknowledged that the Appellants have presented the results to rebut a *prima facie* case of obviousness, but is unconvinced by the data pointing to the statement from the title of Figure 2. The results pointed to the fact that DPPC concentration is not the sole predictor of the insulin formulation, but in fact a critical balance of insulin, DPPC and solution concentration achieved the formulation. According to the data, at concentrations as low as 10 g/L of the total solids (DPPC/insulin/citrate; 4 g/L of DPPC), the 10% insulin containing formulation was unstable compared to the 30% insulin containing formulation where stability was observed even at 20 g/L of the total solids (12 g/L of DPPC). The Appellants did not understand the Examiner's point when she states that "A rather exponential relationship between the amounts of insulin and stability." The Examiner has only looked at the data in a two dimensional point of view and did not consider the fact that the total concentrations of the total solids also play an important role. The improved solubility of the total solids is critical to stability, manufacturability and ultimately, the desired performance of the formulation.

As with previous office actions, the Examiner repeatedly asked for a side-by-side comparison of the Appellants' formulations with the formulations of prior art. Again, the Appellants have provided comparative data with formulations that were even *closer* than those cited in the combined prior art. It is well settled that proof of unexpected properties may be in the form of direct or indirect comparative testing of the claimed compounds and the closest prior art. *In re Payne*, 203 USPQ 245, 256 (CCPA 1979) and *In re Grasselli*, 218 USPQ 769 (CAFC 1983).

Reversal of the rejections is requested.

Respectfully submitted,



Carolyn S. Elmore, Esq.
Registration No. 37,567
Tel: (978) 251-3509
Fax: (978) 251-3973

N. Chelmsford, MA 01863
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